

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 4-11 are pending. New claims 9-11 have been added. New claims 9-10 are supported in the specification at page 23, lines 4-17. New claim 11 is supported by the Examples. Amendments have been made to claims 4, 7, and 8 in response to the rejections under 35 U.S.C. 112, second paragraph, 35 U.S.C. 102, and 35 U.S.C. 103. The amendments to the claims are supported by page 23, lines 4-17 and the Examples. It is believed that no new matter has been added.

Rejections under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 4-8 under 35 U.S.C. 112, second paragraph as being indefinite. The Examiner found claims 4 and 8 unclear. In response, claim 4 has been amended in b) i) to recite "and/or", and to recite the concentration as being "based on the total weight". Regarding claim 8, Applicants submit a person skilled in the art would understand the constituents, in general, refer to the constituents of the oil phase. Therefore, a person skilled in the art would understand those constituents that correspond to a certain melting point and/or those constituents that are not dissolved when read in light of the specification.

In view of the foregoing and the amendments above, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 102 and 103

Claims 4-8 stand rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being obvious over WO 91/18669. According to the Examiner, WO 91/18669 teaches microemulsions which have the property of being transparent or translucent. The Examiner found the reference did not make a distinction between the order of addition of the emulsifiers and co-emulsifiers, and ultimately found the sequence of adding materials or the selection of any order of the steps to be obvious in the absence of new or unexpected result.

In response to the anticipation rejection, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, that the absence in the prior art reference of even a single claim element precludes a finding of anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In response to the obviousness rejection, Applicants point out that obviousness

can only be established by combining or modifying the teachings of the prior art to produce the present invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See* MPEP §2143.01.

Regarding the product claims, Applicants submit that WO 91/18669 contains no teaching or suggestion of a microemulsion that is transparent or translucent. The Examiner cites to the examples in the reference for support, but the examples do not discuss the physical appearance of the finally obtained microemulsion upon cooling. The Examiner appears to believe that the microemulsions are inherently transparent or translucent. If the Examiner is relying on a theory of inherency to establish the transparency or translucence of the microemulsions, Applicants respectfully refer the Examiner to the following from the Board of Patent Appeals and Interferences in *Ex parte Levy*, 17 USPQ2d 1461, 1463-1464 (BPAI 1990):

[T]he initial burden of establishing a prima facie basis to deny patentability to a claimed invention rests upon the Examiner. * * * In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. [Emphasis in original.]

See MPEP §2112 ("Requirements of Rejection Based on Inherency; Burden of Proof").

Even though the reference mentions the microemulsion as transparent, the microemulsion

is not the final product which is obtained once cooled to room temperature. There is no reason to believe the microemulsion will appear translucent once cooled to room temperature. WO 91/18669, at page 6, lines 13-17, only notes the appearance of the microemulsion at 40-60°C, but makes explicit of the fact that the final microemulsion product is obtained once cooled. Therefore, a person skilled in the art would not have been led to the present invention, wherein the microemulsion taught in WO 91/18669 is not necessarily transparent or translucent.

Moreover, Applicants submit the microemulsions of WO 91/18669 are not transparent or translucent, but rather they are opaque. Applicants refer the Examiner to page 9, lines 34-37 of the instant specification. The specification discusses a problem with microemulsions of the prior art which are practically transparent in the PIT or "phase inversion temperature", but become opaque when cooled to room temperature. Each of the examples cited in WO 91/18669 teach a microemulsion which is cooled to room temperature. Therefore, a person skilled in the art would not have been led to the present invention, because when looking to the reference for a teaching or suggestion thereof, it would be reasonable to ascertain the microemulsions of WO 91/18669 to be opaque in appearance rather than transparent or translucent, as instantly claimed. Applicants submit that one of the objectives of the present invention was to overcome the opaque appearance in the microemulsion of the prior art. This objective was achieved by the present invention, as evidenced by the disclosed examples, and therefore overcomes this problem in the prior art. If the Examiner continues to believe the microemulsion is

transparent or translucent, Applicants submit the Examiner to make such a showing of how the microemulsions of WO 91/18669 are necessarily transparent or translucent once cooled to room temperature.

Regarding the process claims, Applicants submit that WO 91/18669 contains no teaching or suggestion of a process for preparing a microemulsion which comprises "first heating the constituents of the oil phase and constituents of the aqueous phase to a temperature above or within the phase inversion temperature", wherein the "process is free of a stirring or homogenization step." Applicants would remind the Examiner that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); See MPEP §2131. WO 91/18669 contains no teaching of any specific process steps for making a microemulsion, wherein no stirring or homogenization is involved. The Examiner, himself, concedes the reference makes no distinction in the steps set forth in the process of making the microemulsion. Therefore, because WO 91/18669 does not teach the specific steps set forth in the instant claims, the claims are not anticipated. Moreover, a person skilled in the art would not have been led to the present invention for lack of guidance in making the determination of the selection of the steps for the process of making the microemulsion. In addition, Applicants point out that there is no teaching of process for making a microemulsion wherein an oil-in-water emulsion is cooled to form an oil-in-water microemulsion. WO 91/18669 contains no such teaching of this

conversion. Rather, the reference teaches a formation of a crude emulsion which is separated into the oil and aqueous phases before forming the microemulsion. Accordingly, because WO 91/18669 neither teaches nor suggests a microemulsion that is transparent or translucent and a process of making thereof, Applicants submit the claims are neither anticipated nor rendered obvious.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw these rejections. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Applicants: EITRICH et al.
Application No. 08/930,235
Amendment in Response to Office Action dated October 20, 2004

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

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